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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

NGUYEN, HUY THANH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2616

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 09/520,968             |  | SAFADI ET AL.       |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | HUY T. NGUYEN          |  | 2616                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 01, 2005 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2,5,16-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando (6,879,773) in view of Metz et al (5,768,539).

Regarding claim 1 and 16, Ando discloses personal versatile recorder (Figs. 14, 3) for recording any type of data comprising:

- a central processing unit (80);

- a data storage device (50,51);

- a connection to a television system for receiving a signal comprising television programming and a data transport stream for transmitting streamed multimedia files or computer software (column 4, lines 30-60, column 14, lines 10-65);

wherein said central processing unit selectively records said television programming and data from said data transport stream on said data storage device (columns 15, lines 65 to column 16, line 30).

Ando fails to specifically teach that the television system is a cable television system and transport stream further having computer software as being recited in claims 1 and 16.

Metz teaches a receiver for receiving transport streams comprising television programming, data and software (column 7, lines 25-68, column 10, lines 5-10, column 42, column 43, lines 1-10, Fig. 1).

It would have been obvious to one of ordinary skill in the art to modify Ando with Metz by providing the apparatus of Ando with a receiving means as taught by Metz for receiving the transport stream, video audio programming from a television cable system as an additional signal source for receiving and recording television

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programming , media files or computer software thereby enhancing the capacity apparatus of Ando for receiving , selecting and recording television programming, data or computer software from a cable system as additional signal source.

Regarding claims 2 and 17, Ando as modified with Metz further teaches the teaches multimedia files comprise one or more of the following a picture file, a graphics file, a video file or an audio file, or any combination thereof (See Ando, column 4, lines 30-60).

Regarding claims 5 and 20, Ando as modified with Metz teaches the data of software of the data transport stream comprises software executable by said apparatus for receiving data of software that excuse a processor for managing the video or audio files ( See Metz ,column 6 and 42).

4. Claims 1-4 ,7, 9, 11,13-14, 16, 17-19,22,26, 28-29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al (6,233,389) I view of Lowell (6,012,086).

Regarding claim 1 and 16, Barton discloses personal versatile recorder (Figs. 1 and 7) for recording any type of data comprising:

a central processing unit (106);

a data storage device (105);

a connection to a cable television system for receiving a signal comprising television programming and a data transport stream for transmitting streamed multimedia files or computer software (column 3, lines 30-60);

wherein said central processing unit selectively records said television programming and data from said data transport stream on said data storage device (columns 3, line 60 to column 4, line 15).

Barton fails to specifically teach the transport stream having media files .

Lowell teach a recording apparatus having means for receiving transmitting data steam having media files from cable system and recording media files (column 1, column 4, lines 30-65 ,Fig. 1) . It would have been obvious to one of ordinary skill in the art to modify Barton with Lowell by providing the apparatus of Barton with a receiving means as taught by Lowell for receiving the media files and recording the media files thereby enhancing the capacity of the apparatus of Barton for additionally recording the media files.

Regarding claims 2 and 17, Barton as modified with Lowell further teaches the teaches multimedia files comprise one or more of the following a picture file, a graphics file, a video file or an audio file, or any combination thereof (See Lowell , column 4, lines 30-65).

Regarding claims 3 and 18, Barton as modified with Lowell further teaches a receiving unit for receiving the web page from an internet (Lowell, columns 3, 4).

Regarding claims 4 and 19, Barton as modified with Lowell further teaches a user interface for controlling said central processing unit to selectively record said television programming and content from said data transport stream (see Barton clumn3, lines 30-60, column 4 line 4-14, Lowell column 6, lines 20-45).

Regarding claims 7 and 22, Barton modified with Lowell further teaches an audio/video output for connecting said recorder to a television set or monitor for outputting programming or data stored on said data storage device to said television set or monitor (See Barton Fig. 1, Lowell Fig. 3).

Regarding claims 11 and 26, Barton as modified with Lowell further teaches an upstream transmitter for transmitting requests for data over said connection (See Lowell (column 5, line 60 to column 6, line 20).

Regarding claims 13,28 and 32, Barton as modified with Lowell further teaches an agent application executed by said central processing unit for identifying and recording or caching data from said data transport stream or television programming that matches parameters input by a user (See Lowell (Fig. 5, column 6, lines 20-45, Barton column 11, lines 25-40).

Regarding claims 14 and 29, Barton as modified with Lowell further comprising generating a multimedia e-mail file or message with said personal versatile recorder (Lowell, column 5, lines 30-60).

Regarding claims 5 and 20, Barton a modified with Lowell further teaches the data of software of the data transport stream comprises software executable by said central processing unit to enable said central processing unit to manage and open any type of multimedia data file or manage any type of data stream as recited in the claims (See Lowell column 4, lines 45-65, column 5 lines 10-20).

Regarding claims 6 and 21, Barton as modified with Powell further teaches use of a hard drive for storing the data (See Lowell column 7, lines 1-5, Barton , Fig. 1).

5. Claims 8-10, 23-25 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al in view of Lowell as applied to claims 1 and 16 above further in view of Lortz (6,349,410).

Regarding claims 8 and 23, Barton as modified with Lowell as modified with L further teach that the recorder is integrated with a set top box (See Barton Fig. 1, . Lortz teaches a recorder integrated with a set top box (column 7, Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art to modify Barton with Lortz by using the teaching of Lortz for integrating the recorder with a set top box thereby providing more convenience to the user in handling recording the selected video and audio data.

Regarding claims 9,10, 24 and 25, Barton as modified with Lowell and Lortz further teaches using a first tuner and a second tuner (See Barton column 1, line s30-55).

Regarding claim 39, Barton as modified with Lowell and Lortz further teaches decreasing traffic on a network carrying said television programming, streamed audio visual content, multimedia file or software by caching data on said personal versatile recorder (see Lortz column 8, lines 1-10).



6. Claims 15 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al in view of Lowell as applied to claims 1 and 16 above further in view of Tomitsuka et al (5,566,271).

Regarding claims 15 and 30, Barton fails to teach verbally inputting parameters or commands to applications running on said central processing unit with a voice recognition system.

Tomitsuka teaches an apparatus a voice system for verbally input parameter or command to applications running on said central processing unit (Abstract, column 14).

It would have been obvious to one of ordinary skill in the art to modify Barton with Tomitsuka by providing the recorder of Barton with a voice recognition system as taught by Tomitsuka in order to enhance capacity of the apparatus Barton apparatus to provide more convenience the user in operating the apparatus .

7. Claims 31 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al in view of Lowell as applied to claims 1 and 16 above further in view of Tsukidate (6,714,722).

Regarding claims 31 and 41, Barton as modified with Lowell fails to teach a content rights management system that prevents or limits recording or copying of data stored on said data storage device.

Tsukidate teaches a multimedia recorder having a copy management system that limits recoding copy (column 10) . It would have been obvious to one of ordinary

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skill in the art to modify Barton as modified with Lowell with Tsukidate by providing the apparatus of Barton with a copy management system thereby enhancing the capacity of the apparatus of Barton to prevent unauthorized person from copy of the stored data .

8. Claims 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al in view of Lowell as applied to claims 1 and 16 above further in view of Kunnel (5,961,603).

Regarding claims 40 and 42, Barton fails to teaches using universal resource locator for accessing the television programming and transmitting advertising to said personal video recorder in said composite signal, wherein said advertising is targeted to said recorder based on demographic or preferences associated with a user of said recorder.

Kunnel teaches apparatus having a mean for accessing television programming by using a universal resource locator in a composite signal and for receiving unit for receiving advertising bases ion demographic (Abstract ,column 5, lines 1-25, column 12, lines 45 to column 13, line 35).

It would have been obvious to one of ordinary skill in the art to modify Barton with Kunnel by using a receiving means as taught by Kunnel with the apparatus of Barton for receiving television programming and using URL for accessing the television programming to receive the advertising from internet source, thereby enhancing the capacity of the apparatus of Barton .

9. Claims 12 and 27 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al in view of Lowell as applied to claim 1 and 16 above , further in view of Stone (JP407093891A).

Regarding claims 12 and 27, Barton as modified with Lowell fails to teach compression means for compression the data by user .

Stone teaches an apparatus having a compression means for compressing video data by using a user interface . It would have been obvious to one of ordinary skill in the art to modify Barton with Stone by providing the apparatus of Barton with a compression means as taught by Stone for compressing the data in order to compensate the fidelity of the data .

### ***Response to Arguments***

10. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

  
HUY NGUYEN  
PRIMARY EXAMINER